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EXAMINER

FABER, DAVID

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/621,275
Filing Date: July 17, 2003
Appellant(s): DAVIS ET AL.

Mary J. Breiner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 September 2007 appealing from the
Office action mailed 28 June 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6853980	Ying	2-2005
6882334	Hayes	4-2005

20030119478	Nagy	6-2003
20010042124	Barron	11-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 6, 10, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Hayes et al (US Patent #6,882,344, filed 7/25/2000).

As per independent Claim 1, Ying et al discloses a method comprising:

- A font consumer requesting a font from a font provider (FIG 29, 54; Column 22, lines 31-42: Discloses a user having the ability to request a font from the font store)
- The font provider accessing subscription information from the font customer; (Column 10, line 64 - Column 11, line 3: Discloses a record of previous purchase and financial information about the customer's account. In addition, Column 30, lines 22-30 discloses the purchase of the font covers the licensing of the font wherein the license includes the length of time the font may be used.)
- The font provider sending the requested font to the font customer depending on the subscription information; (FIG 35-37: Discloses the use of payment wherein once font provider receives payment, then the font provider provides the font customer the font to be downloaded.) the font provider giving lifetime

information with the requested font, the lifetime information defining a predetermined period of time for which the font consumer is authorized to use the requested font and defining a predetermined access for use based on the subscription information. (Column 30, lines 22-30 discloses the purchase of the font includes a license wherein the license describes the length of time for the font could be used and authorized use such as limitations of downloads, copying, number of machines it may be used on, and the number of characters of a given font can be used; thus disclosing the license includes a predetermined period of time and access for use)

Ying et al discloses the font consumer receiving the requested font and providing the requested font to an application by installing the requested font in the font consumer for the predetermined period of time and for the predetermined access (Claim 6, Column 32-33: Discloses downloading a font to the client whereby used by the client's operating system. Column 11, lines 49-56: discloses a font manager installing the font; Column 30, lines 22-30: discloses the font license how long the font may be installed and what access rights are allowed for font)

However, Ying et al fails to specifically disclose the required font is tracked so that upon expiration of said predetermined period of time, the font is disabled. However, Hayes et al discloses a feature of a font for sale could be sampled for a period of time and disabled when the font when the time expired. (Column 8, lines 46-48) It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified Ying et al's method with Hayes et al's feature of disabling the

font after the predetermined time expired in order to provide a font management system for implementing limited access to fonts after terms of agreement have expired.

As per dependent Claim 2, Ying et al discloses a method further comprising:

- the font consumer accessing a web site of the font provider; (FIG 5,50: Browser access the main homepage of font store)
- the font consumer logging onto the web site; and (FIG 32-33; Column 23, lines 17-33)
- the font consumer identifying the requested font. (FIG 29: Fonts identified by the request are added to the user's shopping cart account whereby the customer is able to identify the fonts selected)

As per dependent Claim 3, Ying et al fails to specifically disclose the font provider is able to accessing a subscriber database; looking up the font consumer in the subscriber database, and reading font privileges associated with the font consumer. However, Ying et al discloses an e-commerce server by the font store that includes a database containing data for each customer that includes an ID, user name, user password, shopping cat for storing fonts not purchased yet, and account history that include record of previously purchased fonts and financial information of the customer's account. (FIG 1; Column 10, line 64 - Column 11, line 3) In addition, Ying et al discloses the use of licenses on the limitations on the purchase of fonts. (Column 30, lines 22-30) It would have obvious to one of ordinary skill in the art at the time of applicant's

invention to have used Ying et al's method with the font store to have access user privilege and financial information since it would have enabled a system to aid in the distribution, buying, and selling of fonts.

As per dependent Claim 6, Ying et al discloses a method comprising:

- the font provider giving privilege information with the font, the privileges information defining approved uses for the requested font by the font consumer. (Column 30, lines 22-30: Discloses the use of a license of limitations of use on copying, distribution among machines, and number of characters used.)

As per dependent Claim 10, Ying et al discloses a method comprising:

- the installing of the font occurs in random access memory of the font consumer. (Column 11, lines 50-55: discloses a font manager installing fonts. It is inherent, in order for it to be used by applications such as a word processing program, for the requested font to be installed into random access memory.)

As per independent Claim 18, Ying et al discloses a method comprising:

- a font consumer requesting a font from a font provider (FIG 29) and providing payment for the font; (FIG 34-35) based on subscription information defining a specified time period of use and a specified use access (Column 30, lines 22-30:

Ying et al clearly discloses "When the sale or purchase of fonts those words are meant to cover licensing of fonts in return for money as well as their outright sale." The license describes the length of time for the font could be used and authorized use such as limitations of downloads, copying, number of machines it may be used on, and the number of characters of a given font can be used; thus disclosing the license includes a predetermined period of time and access for use.)

- the font provider sending the requested font to the font consumer (FIG 37 – the store server sends the font once it receives a request for a font download) along with a license for the font consumer that enables the font consumer to use the font for a specified time period and the specified use access; and (Column 30, lines 22-30 – Discloses the license to include the length of time that could be used and specified use access of the font)

Ying et al discloses the font consumer receiving the requested font and providing the requested font to an application (Claim 6, Column 32-33: Discloses downloading a font to the client whereby used by the client's operating system.) for the specified period of time at specified use access (Column 30, lines 22-30 – Discloses the license to include the length of time that could be used and what access right can be used of the font during that time)

However, Ying et al fails to specifically disclose that upon expiration of said predetermined period of time, the requested font is disabled. However, Hayes et al

discloses a feature of a font for sale could be sampled for a period of time and disabled when the font when the time expired. (Column 8, lines 46-48) It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have combined Hayes et al's method with Hayes et al's feature of disabling the font after time expired in order to provide a font management system for implementing limited access to fonts after terms of agreement have expired.

As per dependent Claim 19, the applicant recites similar limitations for performing the method of Claim 1. Therefore, Claim 19 is similarly rejected under rationale.

As per dependent Claim 20, the applicant recites similar limitations for performing the method of Claim 2. Therefore, Claim 20 is similarly rejected under rationale.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further in view of Nagy et al (US PGPub 2003/0119478, filed 7/22/2002).

As per dependent Claim 4, Ying et al fails to specifically disclose further comprising debiting an account of the consumer. However, Nagy et al discloses the use of a subscriber entering a debit card number into a website and the subscriber's card account is debited. (Paragraph 0004, lines 7-10)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ying et al's method with Nagy et al's method since Nagy et al's method would have provided a method and system for prepaying that

enables the use of debit card payments which can be accepted from virtually any issuing financial institution.

Claims 5, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further in view of Barron (US PGPub 2001/0042124, filed 1/26/2001).

As per dependent Claim 5, Ying et al fails to specifically disclose that the font provider encrypting the font prior to transmission to the font consumer. However, Barron discloses a method of encrypting electronic data into an encrypted data packet on a server prior to being retrieved. (Paragraph 0023, line 7 – Paragraph 0024, line 2).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ying et al's method with Barron's method since Barron's method would have facilitated virtually impregnable security for the delivery, storage and sharing of documents and files.

As per dependent Claim 21, the applicant recites similar limitations for performing the method of Claim 5. Therefore, Claim 21 is similarly rejected under Ying et al and Barron.

Claims 11, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further view of Ying et al (US Patent #6,853,980, filed 9/7/1999).

As per independent Claim 11, Hayes et al discloses system on a computer comprising:

- a font request interceptor receiving demands for fonts from applications running on the computer; (e.g. Column 1, lines 63-65; Column 7, lines 7-18 – A user selects a font from a word processing system wherein the operating system responds to the action, and returns the details of the font for use in the word processing program. Therefore, the operating system act as a interceptor.)
- a font retriever for requesting the demanded fonts from a remote font provider if the demanded fonts are not installed on the computer; (Column 7, lines 25-36)
- a font installer for receiving and installing the demanded fonts; and (Column 7, line 63 – Column 8, line 5; Column 4 lines 32-33 – The update function receives the font onto the font manager wherein the user can activate the font in which the font manager installs the activated font.)
- font tracker for monitoring and controlling use of the demanded fonts by the applications in response to privilege information, defining a predetermined use access, received from the remote font provider. (Column 3, lines 38-45 – Discloses an embodiment of predetermined use access wherein the maximum number of users, e.g. licensees, are able to access the font. Discloses the state of monitoring and controlling the use by disclosing the maximum number of authorized users of using the font is ten, and if the

number of users goes above ten, then the others above ten accessing the font will be denied. Shows consistency that if the license states only ten authorized users are only allowed to access the font, then no more than ten users are able to access the font.)

However, Hayes et al fails to specifically disclose said privilege information defining a predetermined time period of use, where the font tracker disables the demanded font after expiration of said predetermined period of time. However, Hayes et al discloses a feature of a font for sale could be sampled for a period of time and disabled when the font when the time expired. (Column 8, lines 46-48) It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified Hayes et al's method with Hayes et al's feature of disabling the font after the predetermined time expired in order to provide a font management system for implementing limited access to fonts after terms of agreement have expired.

In addition, Hayes et al fails to specifically disclose the font retriever providing subscription information to the remote font provider. However, Ying et al discloses when purchasing a font, information regarding the license is sent containing of the length of time the font can be used. (FIG 35-37: Discloses the use of payment wherein once font provider receives payment, then the font provider provides the font customer the font to be downloaded. Column 30, lines 22-30 discloses the purchase of the font includes a license wherein the license describes the length if time for the font could be used and authorized use such as limitations of downloads, copying, number of machines it may

be used on, and the number of characters of a given font can be used; thus disclosing the license includes a predetermined period of time and access for use.)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Hayes et al's method with Ying et al's method's feature of selling the use of fonts for a period of time and access since Ying et al's method would have provided a system which aids in buying, selling, and distribution of fonts.

As per dependent Claim 13, Hayes et al fails to specifically disclose the font retriever accesses a web site of the font provider and logs onto the web site to be identified by the font provider. However, Ying et al discloses accessing a web site of the font provider; (FIG 5,50: Browser access the main homepage of font store), logging onto the web site to be identified by the font provider. (FIG 32-33; Column 23, lines 17-33)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Hayes et al's method with Ying et al's method of accessing and logging into a website of a font provider since Ying et al's method would have provided a system which aids in buying, selling, and distribution of fonts.

As per dependent Claim 17, Hayes et al discloses a method comprising: installing the font in random access memory of the font consumer. (It is inherent for a font to be installed into random access memory in order for it to be used by applications such as a word processing program.)

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over by Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further view of Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Barron (US PGPub 2001/0042124, filed 1/26/2001).

As per dependent Claim 14, Hayes et al and Ying et al fails to specifically disclose that the font retriever decrypts the demanded font. However, Barron discloses a method of downloading a decryption applet and decrypting the encrypted data packet at the client workstation. (Paragraph 0024, lines 9-13).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ying et al's method with Barron's method since Barron's method would have facilitated virtually impregnable security for the delivery, storage and sharing of documents and files.

(10) Response to Argument

On pages 7-10, Appellant argues that Ying and Hayes do not render independent claims obvious within the meaning of 35 USC 103. Appellant argues Ying does not teach a method or system for distributing or managing fonts by rental involving the combination of features as claimed by appellants and that Ying provides no description as to how to provide or implement or enforce a license or sale including limitations. In addition, Appellant argues Hayes describes a system and method for examining font files for corruption, a method or system for renting a desired front for a predetermined period of time and access is not described; therefore, submitting that the modification

necessary to the teaching of Hayes to obtain the claimed methods or systems is beyond the teaching or suggestion of Ying or Hayes. As a result, Appellant states the claimed methods and systems have a different purpose and are defined by specific features to achieve that purpose that are not taught or suggested by Ying or Hayes. However, the Examiner disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., to provide or implement or enforce a license or sale including limitations) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Based on the arguments, in reference to Ying, the Examiner is unsure which features and limitations the Appellant stated in the arguments is focusing on (e.g. Page 9, second paragraph) since the Appellant is arguing the claims as a whole in respect to Ying. Therefore, the Examiner is viewing the argument as in Ying does not teach the limitations of Claim 1.

Ying provides a method for distribution or managing fonts by rental based on the limitations on Claim 1.

- Ying discloses a font consumer requesting a font from a font provider, disclosed in FIG 29, 54; Column 22, lines 31-42, wherein Ying discloses the user has the ability to request a font to purchase or download in which the user selected from the font store.
- Ying discloses the font provider accessing subscription information from the font customer, disclosed in Column 10, line 64 - Column 11, line 3, wherein Ying discloses information of a record of previous purchase and financial information about the customer's account is stored for access. In addition, Ying further discloses that customer account involves the purchase of the font covers the licensing of the font wherein the license includes the length of time the font may be used as disclosed in Column 30, lines 22-30.
- Ying discloses the limitation the font provider sending the requested font to the font customer depending on the subscription information, disclosed in FIG 35-37, wherein the figures disclose processing of a payment wherein once font provider receives payment, then the font provider provides the font customer the font to be downloaded.
- Ying discloses the font provider giving lifetime information with the requested font, the lifetime information defining a predetermined period of time for which the font consumer is authorized to use the requested font and defining a predetermined access for use based on the subscription information as in

Column 30, lines 22-30, wherein Ying discloses the purchase of the font includes a license wherein the license describes the length of time for the font could be used and authorized use such as limitations of downloads, copying, number of machines it may be used on, and the number of characters of a given font can be used; thus disclosing the license includes a predetermined period of time and access for use.

- Ying et al discloses the font consumer receiving the requested font and providing the requested font to an application by installing the requested font in the font consumer for the predetermined period of time and for the predetermined access as disclosed in Claim 6, Column 32-33, wherein Ying discloses downloading a font to the client whereby used by the client's operating system wherein the client has a font manager in which the font manager installs the font (disclosed in Column 11, lines 49-56. Furthermore, Ying discloses the font license how long the font may be installed and what access rights are allowed for font, as disclosed in Column 30, lines 22-30.

However, Ying et al discloses that a license that involves the length of time and use of access, but fails to specifically disclose the required font is tracked so that upon expiration of said predetermined period of time, the font is disabled. However, Hayes et al discloses a feature disabling a font after time expires of a font a user had the ability to use the font for a short period of time until further action is decided and done by the user. (Column 8, lines 46-50) It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified Ying et al's method with

Hayes et al's feature of disabling the font after the predetermined time expired in order to provide a font management system for implementing limited access to fonts after terms of agreement have expired. The Examiner is not combining whole inventions by brute force when the Examiner stated the obvious statement in the Office Action. The Examiner is modifying Ying's invention of distributing fonts to include the feature that is disclosed in Hayes, not the entire invention, based on what is stated in the language of the claim language. While Hayes discloses the ability to examine font files for corruption in other aspects of the invention wherein Hayes, Hayes also discloses the feature to distribute and manage fonts by having font be used by users for a short time, then disabled when time expires. Thus, Ying and Hayes disclose a common endeavor in the same field of art since Ying and Hayes discloses distributing and managing fonts. In conjunction with Ying, Ying and Hayes provide a license that defines the length of time usable and access rights, wherein the length of time expires, the font would be disabled until further action is decided by the user which provides a font management system aiding in buying, selling, and distribution of fonts and for implementing limited access to fonts after terms of agreement have expired.

All other arguments on pages 12-14 are referring to the dependent claims and parallel claims are in reference to the topics above, thus the rationale above can be used to respond to the similar arguments.

Art Unit: 2178

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

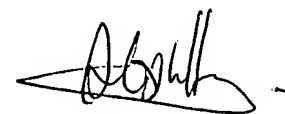
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

David Faber



Conferees:



STEPHEN HONG
SUPERVISORY PATENT EXAMINER



Stephen Mong, Supervisory Patent Examiner for Group Art Unit 2178



Doug Hutton, JR, Supervisory Patent Examiner for Group Art Unit 2176